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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,400	12/28/2001	Shinji Yamasoto	7388/72545	1864
22242	7590	12/23/2003	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			PICKETT, JOHN G	
		ART UNIT		PAPER NUMBER
		3728		
DATE MAILED: 12/23/2003				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/019,400	YAMASOTO ET AL.
	Examiner Gregory Pickett	Art Unit 3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 7-12 is/are rejected.
- 7) Claim(s) 6 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received..
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. .	6) <input type="checkbox"/> Other: _____ .

### DETAILED ACTION

1. The examiner notes that the previous Office action, Paper No. 6, contained a typographical error. In formulating the rejection under 35 U.S.C. 103(a), the examiner inadvertently left out the word "not" in stating what was not expressly disclosed in the Yuichi reference.
2. This Office action acknowledges the applicant's Amendment B, presented as Paper No. 9. Claims 1-12 are pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The following is a quotation from MPEP 710.06:

If the error is brought to the attention of the Office within the period for reply set in the Office action but more than one month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. (emphasis added)

Since the applicant did not request a restart of the period for reply, the applicant is incorrect in the assertion that the Office is responsible for any slight delays in prosecution due to the absence of a translation of the Yuichi reference provided in the first Office action, Paper No. 6.

Further, the examiner notes that the reference in question (JP 04-189779 A to Yuichi) was supplied by the applicant in Paper No. 4, cited in the PCT/IPEA/409 report

dated 11 July 2001 as having the entire text pertinent to the patentability of claims 1 and 5, and cited in the PCT/ISA/210 report dated 3 October 2000 as having the full text pertinent to the patentability of claims 1 and 5. The MPEP lays no burden on the Office for the provision of a translation of the foreign document in this case. The provision of the translation was performed as a courtesy by the examiner to the applicant (at the applicant's request) in order to expedite the prosecution of the case.

***Claim Objections***

5. In light of the applicant's amendment, the objection to claim 5 is hereby withdrawn.
  
6. Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim 6 has not been further treated on the merits.

***Claim Rejections - 35 USC § 103***

7. Claims 1-4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuichi (JP 04-189779 A).

Regarding claim 1, Yuichi discloses a patch package comprising a laminated material (11) with a first resin (13) containing inorganic filler (e.g. silica gel, active alumina, and synthetic zeolite) and situated between a moisture permeable layer (14) composed of a second resin and a screen material (12) which blocks penetration of

moisture and light. The package of Yuichi is shaped into a pouch (Figures 2 and 4) with the moisture permeable layer on the inside.

The package of Yuichi does not expressly disclose the specific material properties and permeabilities claimed by the applicant. Yuichi teaches the adjustment of the moisture absorbing speed through material selection and thickness, thereby indicating the material selection and material thickness as result effective variables. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Yuichi with the values claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to claim 2, Yuichi discloses a first resin as belonging to the olefin group (of which includes polyethylene), a second resin of polyethylene, and a screen material of aluminum composite film. Yuichi teaches the adjustment of the moisture absorbing speed through material selection and thickness. High Density Polyethylene (HDPE)-foil laminates and Low Density Polyethylene (LDPE) resins are known in the medicinal packaging art. The package of Yuichi discloses the claimed invention except for specifically stating LDPE and HDPE-Foil. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Yuichi with the materials claimed by the applicant, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claim 3, Yuichi discloses a thickness of  $10\text{-}50\mu$ , placing it in the same usage scale as the applicant's claimed invention. Gauging from Figure 1, the film of Yuichi (when provided in a  $50\mu$  thickness), has roughly a  $10\mu$ ,  $30\mu$ ,  $10\mu$  arrangement, whose values are within the ranges claimed by the applicant.

As to claim 4, Yuichi discloses heat-sealing the package through film (14). The package of Yuichi discloses the claimed invention except for the heat seal strength. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Yuichi with a heat seal strength as claimed by the applicant since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 7-12 are merely specific thicknesses and permeabilities of the individual layers. Yuichi discloses the general conditions claimed by the applicant. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukahara et al (JP 7-28550 A) in view of Yuichi.

As mentioned in the PCT/IPEA/409 dated July 11, 2001 provided by the applicant, Tsukahara et al discloses a patch in a package with the claimed adhesive. The package of Tsukahara et al does not disclose the package having the claimed

moisture absorbing properties. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the package of Tsukahara et al with the moisture regulating features of Yuichi in order to regulate the moisture in the package and ensure an extended storage time.

As to the specific area ratio, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Response to Arguments***

9. Applicant's arguments filed October 14, 2003 have been fully considered but they are not persuasive.

In the previous Office action, Paper No. 6, the examiner has clearly presented the rejection of claims 1-4 in the form required for 35 U.S.C. 103(a) as required under the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). If the Yuichi reference had shown the specific material properties and permeabilities claimed, the reference would have been applied under 35 U.S.C. 102(b). The examiner clearly presents how the specific material properties and permeabilities claimed would have been obvious to one of ordinary skill in the art through routine refinement as per the decision of In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The examiner asserts that the reliance on the decisions of Boesch and Aller is proper. Yuichi discloses a package with the claimed layer arrangement. Yuichi uses

the arrangement for the same purpose as that of the applicant. The package of Yuichi is on the same general scale as that of the applicant. Yuichi further provides the motivation by suggesting that the moisture-absorbing rate can be adjusted by material selection and thickness. Yuichi discloses the general conditions claimed by the applicant, and where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. It is noted that skill, not the obverse, is presumed of the ordinary artisan. The applicant has merely refined the general conditions disclosed by Yuichi to suit the intended use. Barring a showing of unexpected results, the rejections under 35 U.S.C. 103(a) stand.

As to the thickness, the fact that the reference allows for greater thicknesses does not detract from the fact that the claimed values are disclosed. Further, Yuichi suggests that the variation of the thickness can be used to modify moisture-absorbing rates.

As to the heat seal strength, as previously presented by the examiner, Yuichi discloses the general conditions claimed, and where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*gpr*  
Gregory Pickett  
Examiner  
December 15, 2003

*Mickey Yu*  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700